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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/998,415	<b>Applicant(s)</b> WIGINTON ET AL.	
	<b>Examiner</b> Todd Ingberg	<b>Art Unit</b> 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/29/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Claim Status

Claims 1 – 13 and 21 - 32 have been examined.

Claims 1, 11, 21, 29, and 32 have been amended.

Claims 14 – 20 have been canceled.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. “First User” critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

3. The term “*complex software packages*” has no support in the Specification to make a determination of what is complex and what is not complex. This limitation has no patentable weight. What is deemed complex to one of ordinary skill in the art may not be deemed complex by another of ordinary skill in the art.

These terms fail to provide a quantifiable distinction and are subject to opinion and speculation. These terms hold no patentable weight.

4. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “installing”, does not reasonably provide enablement for “implementing”. The specification does not enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to software installation, the invention commensurate in scope with these claims. The Applicant has introduced the term “implement” or implementation while replacing the term install and installation. The Specification on page 6 has the word “**implementation**” but the word is not a term in the context to the invention only in a legal context.

5. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “**implementation**” and “**implement**” are not supported in the Specification. These terms are new matter.

6. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “**independent module**” is not supported in the original disclosure and is deemed new matter.

7. Claims 1 – 7 and 29 - 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations containing the following: wherein later addition of

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independent modules uses the solicited information from the non-expert user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the a user, are not supported in the original disclosure and is deemed new matter. Claim 7 contains “*intermediate user*” (deleted from claims 21 and 29). which is not supported. How “*ensuring*” is performed as claimed with “ensure the later addition independent modules are implemented consistent with the software package” is new matter.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Profit as documented in “The Official Software Companion Microsoft Profit”, Microsoft Press by Stephen L. Nelson, published 1993. (referred to as **Profit1**).

#### **Claim 1**

**Profit1** anticipates a method in a computer system for enabling the development of implementation installation software (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C ), by an expert for use by a user to solicit and implement business related data for a software package comprising at least one independent module (**Profit1**, Chapter 2, page 33, Select Business Type Figure 2-1 , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user ), the method comprising the steps of:

generating at least one question definition screen (**Profit1**, pages 26, 33 and 228-229);

entering by the expert at least one question on the at least one generated question definition screen (**Profit1**, pages 26, 33, and 228-229 as per above the select business type , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the at least one question entered by the expert being designed to solicit at least first information from an non-expert end user relating to a business of the end user (**Profit1**, pages 33 and 228-229, entry is a response to question , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user);

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determining whether additional information relating to the business of the non-expert end user is necessary to implement a the software package on a computer system of the end user (**Profit1**, page 35, select from Figure 2-2 determination made if Figure 2-3 is needed – the actual software installed is determined by the answer to the questions, , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information (**Profit1**, pages 26, 33, and 228-229 as per above the select business type );

if additional information is necessary, providing links to next questions to solicit additional information (**Profit1**, page 35, NEXT button on the bottom of screen);  
if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the end user (**Profit1**, page 26 and 35, Business set up to set up the components requested); and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user (**Profit1**, page 26 and 35, Business set up to set up the components requested - , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user).

### Claim 3

The method of claim 1, including the step of: saving the at least one question prior to a determination that additional information is not necessary. (**Profit1**, page 227, must determine where to install, Figure 8-2).

### Claim 4

The method of claim 1, including the step of: providing links to help files (**Profit1**, pages 24 - 28, Help Contents), wherein such help files assist the non-expert end user in providing at least one response to the at least one question, the at least one response relating to the business of the non-expert end user (**Profit1**, page 26 and 35, Business set up to set up the components requested - , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user).

### Claim 5

The method of claim 4, further comprising the step of providing at least one derived response for the at least one question, the at least one derived response corresponding to a generally accepted accounting principle. . (**Profit1**, page 66 – 68, General Ledger and Fiscal periods and year).

### Claim 7

**Profit1** anticipates an apparatus for enabling the development of **implementation** installation software wizards **for complex software packages comprising at least one independent**

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**module (Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1 ), comprising: at least one memory; at least one executable file stored in the at least one memory; the at least one executable file comprising at least one instruction for providing at least one question definition screen (**Profit1**, Chapter 2, page 33, Description of Company, Figure 2-1); a monitor; at least one processing unit to execute the at least one instruction to display the at least one question definition screen to at least one intermediate user (**Profit1**, page 33, Description of Company, Figure 2-1 – This is a Wizard); the at least one processing unit includes at least one input so the at least one intermediate user can input at least a first question (**Profit1**, page 33, Responding to the question on page 33), the first question to solicit information from an end user relating to a business of the end user (**Profit1**, page 33, Description of Company, Figure 2-1); such that the end user can input business information specific to the end user (**Profit1**, page 35, Figures 2-2 and 2-3); and a compiler to write all the received information (**Profit1**, page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions ), wherein the received information is saved for the end user (**Profit1**, page 34, After the NEXT button is selected the information is saved the next part of the Wizard asks Company level information and page 75 end of questions mentions double checking your work and storing), wherein execution of the executable file solicits information from the end user to set options in and implement the **at least one independent module of the complex software package (Profit1**, page 33, Description of Company, Figure 2-1 and page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions).

**Claim 9**

The apparatus of claim 7, wherein the at least one memory comprises at least one help file. (Profit1, pages 22 – 23, reference book stored in the computer's memory ).

**Claim 10**

The apparatus of claim 7, wherein the at least one processing unit includes a security module. (Profit1, page 36 – 38, Passwords and controlling access is a Security Module).

**Claim 11**

**Profit1** anticipates a computer program product comprising: a computer usable medium having a computer readable code embodied therein for processing data to develop implementation installation software wizards set up by an expert to assist a end users in installing business related **complex software packages (Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1, The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), comprising **at least one independent module** on a computer system of an end user (**Profit1**, page 33, Select Business Type Figure 2-1, The Microsoft programmer who created the software is an expert – the user handling the questions is the end user ),

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the computer usable medium comprising: a question generation module configured to generate at least one question definition screen (**Profit1**, pages 26, 33 and 228-229, for the selected business type above); a receiving module configured to receive at least one question designed to solicit information from end user relating to a business of the end user (**Profit1**, pages 33 and 228-229, entry is a response to question and **Profit1**, Chapter 2, pages 32 – 36, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership .....);

a determining module configured to determine whether the business related **complex** software **packages** requires additional information to **implement** the business related **complex** software the computer system of the end user; a linking module configured to provide links to next questions if additional information is determined to be needed to **implement** the business related **complex** software (**Profit1**, page 35, NEXT button on the bottom of screen); for the end user question (**Profit1**, pages 26, 33, and 228-229 as per the select business type ); a saving module configured to save the at least one received question (**Profit1**, page 76, finished answering the questions stores the information ); and a compiling module configured to write the at least one received question (**Profit1**, page 32-36 as per above ) saved by the saving module into the **implementation** software wizard for the end user. (**Profit1**, page 33, Description of Company, Figure 2-1 and page 76, In Conclusion, After the Questions of Chapter 2 are answered the information compiles the answers and generates an accounting package to meet the accounting needs described by the answers to the questions).

### Claim 13

The computer program product of claim 11, comprising: a help module configured to provide help relating to the at least one question. (**Profit1**, pages 22 – 24, Help on specific topics and page 20, Help button on the selection in Figure 1-13).

### Claim 21

**Profit1** anticipates a method in a computer system for enabling the development of implementation installation software (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1 ) by an **expert** for use by a **end user** to solicit and implement business related data for a software package comprising at least one independent module (**Profit1**, page 33, Select Business Type Figure 2-1 ), the method comprising the steps of:

generating at least one question definition screen (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1 );

entering by the **expert** at least one question on the at least one generated question definition screen (**Profit1**, pages 26, 33 and 228-229, for the selected business type above , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user), the at least one question entered by the **expert** being designed to solicit at least first information from an end user relating to a business of the **end user** (**Profit1**, pages 352 – 356, Microsoft distribution of product as evident in Appendix C and Wizards as evident by page 33, Description of Company, Figure 2-1 , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user);



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determining whether additional information relating to the business of the **end user** is necessary to implement a the software package on a computer system of the **end user**, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information (**Profit1**, page 35, NEXT button on the bottom of screen) ,The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership ..... – more than one question present in article);

if additional information is necessary, providing links to next questions to solicit additional information (**Profit1**, page 33, Select Business Type Figure 2-1 and **Profit1**, page 35, NEXT button on the bottom of screen), if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from **the end user relating to the business of the end user** (**Profit1**, pages 26, 33 and 228-229, for the selected business type above , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user) **such that the solicited information from the user** is used to set specific options in the **at least one independent module of the software package** (**Profit1**, pages 26, 33, and 228-229 as per the select business type ); requiring the solicited information so the **at least one independent module of the software package** can be **implemented** and installed on the computer system of the end user (**Profit1**, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership .....); and

wherein later addition of independent modules uses the solicited information from the **end user** to ensure the later addition independent modules are implemented consistent with the software package **Profit1**, page 35, NEXT button on the bottom of screen); and at least the first information relating to the business of the **end user** ( The intended use of a Installation Wizard as per - Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership ..... , The Microsoft programmer who created the software is an expert – the user handling the questions is the end user).

#### **Claim 22**

The method of claim 21, further comprising the step of generating at least one help definition screen for each edit question screen. (**Profit1**, pages 25 – 28, Help by Topic for Setting Up and Customizing ).

#### **Claim 23**

The method of claim 21, further comprising the step of providing a default business operating information answer for each generated edit question screen. (**Profit1**, page 48, Default settings – for purchases – Figure 2-11).

#### **Claim 25**

The method of claim 21 wherein the determining step includes comparing whether the inputted at least one question solicits all the plurality of business operating information necessary to install the business related software. (**Profit1**, pages 32 to 76 - Starting ).

#### **Claim 26**

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The method of claim 21, further comprising the step of saving the inputted at least one question and jump information prior to compiling the business software installation application.  
(Profit1, page 76, Final Starting decision ).

#### **Claim 27**

A computer-readable medium having computer executable instructions for performing the acts of claim 1. (Profit1, pages 352 – 356, Profit is a computer executable program as evident by the document and the fact it is installed).

#### **Claim 28**

A computer-readable medium having computer executable instructions for performing the acts of claim 21 (Profit1, pages 352 – 356, Profit is a computer executable program as evident by the document and the fact it is installed).

#### **Claim 29**

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software, by an **expert** for use by a end user to solicit and implement business related data for a software package comprising at least one independent module , the method comprising the steps of:

generating at least one question definition screen ;

entering by the **expert** at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the **end user**;

determining whether additional information relating to the business of **the end user** is necessary to implement a the software package on a computer system of **the end user**, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information;

if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the **end user** relating to the business of the **end user** such that the solicited information from the **end user** is used to set specific options in the **at least one independent module** of the software package requiring the solicited information so the **at least one independent module** of the software package can be implemented and installed on the computer system of the end user and

wherein later addition of independent modules uses the solicited information from the **end user** to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of **the end user**  
(Profit1, as per the rejections for independent claims 1 and 7 above).

#### **Claim 32**

Profit1 anticipates a method in a computer system for enabling the development of implementation installation software, by an **expert for use by an end user** to solicit and implement business related data for a **software package** comprising **at least one independent module**, the method comprising the steps of:

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generating at least one question definition screen; entering by the **expert** at least one question on the at least one generated question definition screen, the at least one question entered by the **expert** being designed to solicit at least first information from an end user relating to a business of the end user determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information;

if additional information is not necessary, compiling the at least one entered question into **implementation** installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be **implemented** and installed on the computer system of the end user; and

wherein later addition of **independent modules** uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user (Profit1, as per the rejections for independent claims 1 and 7 above).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as **Profit1**) as applied to claim 1 above, and further in view of basic use of Encryption as taught by Computer Security Basics from 1991 (Encryption).

### **Claim 2**

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The method of claim 1, including encrypting the stored at least one entered question. Profit1 teaches the use of passwords (Profit, page 37, Figure 2-4 with controls). Passwords must be stored to enable validation (Profit1, page 37, Assigning passwords for users to access the system requires the storing them) . Encryption teaches encrypting passwords page 65. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the use of passwords of Profit1 with Encryption because access control makes systems secure.

**Claim 12**

The computer program product of claim 11, comprising: an encryption module configured to provided encryption. As per claim 2.

**Claim 24**

The method of claim 21, further comprising the step of encrypting the inputted at least one question and jump information. As per claim 2 and Profit1 completing password moving to another screen (Profit, page 37, Figure 2-4 with controls).

12. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as Profit1) as applied to claim 1 above, and further in view of "Setup Factory", User's Guide by Indigo Rose, 1998 (Factory)

**Claim 6**

The method of claim 4, including the step of: emailing a question to a help reference. (Profit1, page10, Support, phone support) (Factory, page 7, email support). Profit1 shows support via telephone but does not show support by EMAIL. It is Factory who teaches support by email. therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Profit1 and Factory, because email support provides for an easy means of providing hardcopy of help suggestions.

**Claim 8**

The apparatus of claim 7, wherein the at least one, memory, the at least one monitor, the at least one processing unit, the at least one input device, and compiler are coupled by at least one of a bus protocol, a wireless protocol, an intranet protocol , an extranet protocol, and html protocols. (Factory, page 7, EMAIL over the Internet uses an internet protocol).

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft

Profit as documented in "The Official Software Companion Microsoft Profit", Microsoft Press by Stephen L. Nelson, published 1993. (referred to as Profit1) as applied to claim 1 above, and further in view of USPN # 5,257,377 Sathi et al, October 26, 1993.

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**Claim 30**

The computer program product of claim 29, further comprising a processor identification module configured to obtain computer system information about the system on which the business software package is being installed (**Sathi**, col 6, line 7 – 20, Processor ID ). **Profit1** teaches the installation of software (**Profit1**, Appendix C). What **Profit1** does not teach is the recording of the processor ID the computer the software is installed on. **Sathi** teaches recording the processor ID. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of **Profit1** and **Sathi** because recording the ID of the machine software is installed on provides a means of preventing piracy.

**Claim 31**

The computer program product of claim 30, wherein the computer information system information includes information necessary to load the computer program. (**Profit1**, Appendix C, Installing Profit )

***Response to Arguments***

The following are the Applicant's arguments followed by the Examiner's Response. The Examiner has placed the arguments regarding U.S.C. 112 issues before the rejections under 35 U.S.C. 102 and 103 because they are germane to the case.

Some OCR errors may be present.

**Applicant's Argument**

"35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1-13 and 21-32 under 35 U.S.C. § 112, first paragraph, as being non-enabling. The applicants respectfully traverse the rejection- As an initial matter, the Examiner has stated: "'First User' critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." It is unclear to applicants how a term, first introduced in an amendment on April 21, 2005 to clarify the distinctions between multiple end users could in anyway be critical or essential to the invention disclosed in the original specification. Moreover, there is not such a requirement or test for the essence of an invention, as the Examiner seems to suggest. Thus, the rejection is not understood fully. Moreover, the Examiner is respectfully direct to MPEP section 2164.08 establishing that the feature must be taught in the specification as critical and further not merely preferred. In this case, the term first user is not highlighted as particularly important in the specification. However, instead of arguing the position, the applicants have amended the recitation back to the term "end user" provided in the original claims of the application."

**Examiner's Response**

Put simply the Applicant has taken terms in the original disclosure and added different meanings to them. The additional meaning provide functionality that was not specified in the original disclosure thus it is new matter. More over the additions appear to be an attempt to overcome the prior art by adding additional roles of users as originally defined in the Specification to one of ordinary skill in the art.

**Applicant's Argument**

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"The Examiner also stated the phrase "End User" to be more than one role. The applicants request the Examiner clarify this statement as the Examiner's position is not understood. The "End User" is the user that installs (i.e., loads and implements) the complex software package. To the extent the Examiner believe End User means something else, the Applicants would request for some clarity on what the rejection means and if the Examiner has a suggestion regarding more appropriate language, the applicants would appreciate such suggested language."

**Examiner's Response**

The End User in Profit can be many roles. In interpreting a reference Examiner's make such determinations. This does not provide enablement for undefined roles in the Applicant's Specification. Furthermore, The end user in Profit can be the one who answers the questions to set up the software and/or the one who enters accounting information.

**Applicant's Argument**

"The Examiner also stated the terms "expert" user and "non expert" user are not mutually exclusive. The Applicants are perplexed by this statement as the terms are in fact mutually exclusive. However, the phrase non-expert has been removed from the claims to expedite the present case. Moreover, it is respectfully submitted that the term expert is sufficiently clear. For example, one of ordinary skill in the art needing an expert in Hyperion enterprise software would certainly know how to contact such as expert. Moreover, complex accounting software programs, such as, the Great Plains Solomon Select/Premier has identifiable experts. Moreover, the present invention specifically states to install complex software, an end user employs a "specially trained software installation expert." Thus, it is respectfully submitted that the term expert is sufficiently quantifiable as it is clearly understood by one of ordinary skill in the art. Regarding the user of the phrase "intermediate expert user," the term intermediate was simply a term to signify prior to the end user. The term is unnecessary and has been eliminated from the claim."

**Examiner's Response**

Applicant's has not distinguished over the Experts of Microsoft who created the commercial product Profit many years prior to Applicant's filing. Applicant's arguments for specific Companies appear to be equal to Microsoft expertise. Amending the user roles has directed the Applicant's claimed invention back into the original grounds of rejection which is what caused Applicant to add new matter to attempt to overcome the prior art.

**Applicant's Argument**

"Regarding the phrase "complex software packages" not having support, the applicants respectfully disagree. The originally specification clearly establishes the type of software package pertinent to the present invention. In one example in the specification, complex software packages are those for which specially trained software installations experts are employed. Moreover, the background of the invention clearly establishes the type of software package at issue in the present invention as complex software packages as those having multiple interrelated operating modules, such as, for example, complex accounting software packages. Moreover, the detailed description the software as having database interactions and pathways (see, for example, page 6, lines 31-3 and other text). Thus, one of ordinary skill in the art would clearly understand the phrase "complex software package" based on reading the specification as a whole, but if the Examiner prefers, the applicants would be happy to remove the designator complex phrase."

**Examiner's Response**

The term "complex" appears on pages 1 and 2 of the Specification and is used to point out weakness in prior art solutions not how to reduce the invention to practice. Furthermore, Applicant is now citing examples which are not quantifiable. Applicant is presenting an argument as evidence. "Moreover, the detailed description the software as having database interactions and pathways (see, for example, page 6, lines 31-3 and other text)." What is and what is not complex is not distinct. Examiner disagrees that one of ordinary skill would understand the term in view of the Specification.

**Applicant's Argument**

"Regarding the Examiner's position that terms are subject to speculation as a basis to reject the claims is misguided. The terms need to be sufficient to explain to one of ordinary skill in the art the scope of the invention. The applicants respectfully submit that the terms provided meet such a requirement. Furthermore, evidence that terms subject to speculation are clear in many patents issued from the patent office. Terms such as, for example, about, approximate, similarly, substantially, etc. are clearly subject to speculation, but regularly allowed. In this regard, the Examiner is respectfully directed to MPEP section 2173 identifying that the terms must define the subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of the terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encourage to suggest claim language to applicants to improve the clarity of precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by the applicants satisfy the statutory requirement." (emphasis in original) To determine whether the terms are reasonably particular, the Examiner should look to the content of the application, the prior art, and the interpretation one of ordinary skill in the art would provide. In fact, the Courts only require the terms to be as accurate as the subject matter permits. Thus, based on the above, it is clear to applicants that the claim terminology is sufficient, but the applicants would be willing to listen to suggestions from the Examiner should the Examiner continue to maintain this rejection. Further, as the MPEP requires, the applicants urge the Examiner to suggest language the Examiner deems more appropriate for consideration should the Examiner maintain the present position."

**Examiner's Response**

It is not the Examiner's role to provide enabling terms for Applicant. If Examiner's see allowable subject matter they will indicate such matter. Applicant to date has failed to comply with "reasonable degree of particularity and distinctness" for terms and provide clear and concise claims that distinguish over prior art of record.

**Applicant's Argument**

"The Examiner further rejected the term implement, implementation, implementing, etc. As explained previously without objection by the Examiner in paper filed September 2004, one of ordinary skill in the art would understand the term install, installation, installing, etc. in the context of the present application to include both loading a program into memory implementing or configuring the databases to function. Furthermore, the ordinary definition of install is "to set in position and connect (i.e., load) or adjust for use (Le-, implement and configure). Moreover, the original specification specifically contemplates using the information provided by the expert and end user to install the software package using databases, pathways, and user information (see

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the original application disclosure at pages 6-7 and other text). Thus, the applicants amended the claims to clarify that the present invention relates to implementation installation and not simply load installation. To the extent the Examiner wishes the applicants to amend the claims to the broader install (which includes both load or implement), the applicants would be happy to do so, but believe the term implement better defines the present invention."

**Examiner's Response**

The term was introduced after the original filing and appears to being leveraged to distinguish the claimed invention. This is new matter.

**Applicant's Argument**

"Regarding the rejection of claim 5 based on the use of the word derived for default, the applicants disagree with the Examiner's position but have amended the claim back to the original language to expedite the application."

**Examiner's Response**

This rejection was withdrawn. The term was present with the original filing (before preliminary amendment).

**Applicant's Argument**

"Regarding the term independent module, the Examiner is respectfully directed to the example provided of Great Plains Solomon Select/Primer where it is explained that the software package comprises over 50 separate modules that can be separately installed depending on a companies needs. It is respectfully submitted that this example fully supports the phrase independent module and the Examiner is reminded that the terms in the claims do not need to have one-to-one antecedent basis in the written description."

**Examiner's Response**

If Applicant is pointing Examiner to the Provisional Application. The provisional was used for securing a filing date (for matter supported). but the Provisional is not incorporated by reference.

**Applicant's Argument**

"Regarding the Examiner's position that the statement "ensure the later addition independent modules are implemented consistent with the software package" is new matter, the applicants respectfully disagree. In particular, the statement is an inherent or necessary quality of using the present invention and as such is not new matter or unsupported by the original disclosure."

**Examiner's Response**

It is possible once the other issues are resolved this limitation may have a meaning that is understandable. The snowball affect of the 112 issues of this case makes this term new matter.

**Applicant's Argument**

"35 U.S.C. §§ 102(b) and 103

In the November 29, 2005 Office Action, the Examiner rejected of claims 1-13 and 21-32 under 35 U.S.C. § 102(b) as being anticipated by a document "The Official Software Companion Microsoft Profit" ("Profit 1"). The Applicants respectfully thank the Examiner for attaching the relevant portion of the prior art. Moreover, the Applicants respectfully traverse the rejection. Further, the Applicants believe the Examiner misstated the rejection and the rejection under 102(b) should have been for claims 1, 3-11, 13, 21-23, 25-29, and 32 rather than claims 1-13 and 21-32. The Examiner further rejected claims 2, 12, and 24 under 35 U.S.C. § 103(a) as being



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unpatentable and obvious in view Profit I in view of a section from "Computer Security Basics. The Applicants respectfully traverse the rejections. The Examiner also rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable and obvious over Profit in view of Profit I in further view of United States Patent 5,257,377 ("Sathi et al.") The Applicants respectfully traverse the rejections.

Regarding the Examiner's remarks to Applicants arguments, it is respectfully submitted the majority are moot in view of the above and below remarks.

The applicants wish to address the 35 U.S.C. §§ 102(b) and 103(a) first below because it appears the Examiner may misunderstands the present invention. In particular, the Examiner relies on a disclosure that relates to a software package, more particularly an accounting software package. To assist in the installation of the software package, the software package is provided with an installation wizard. Applicants do not dispute that the Profit software as detailed more below in fact has an installation wizard. However, the present invention relates to a method and device for "the development of implementation installation software." Conversely, and at most, the Profit software and its associated manuals at most have installation software. They do not disclose, suggest, teach, or even describe "the development of the implementation installation software," but rather only disclose using such implementation installation software provided. The applicants submit that the references have nothing to do with the development of the installation software, but rather the use. Moreover, many different programming techniques may have been used to develop the installation software, and the applicants respectfully submit that the Examiner is using improper hindsight in view of the present invention to assume the installation software provided must have been developed using the present invention."

#### **Examiner's Response**

Applicant's commercial product may distinguish over Microsoft Profit. However, the distinguishing features may not have made it in the Specification. Applying the reference has not been hindsight. It has been anticipations for the most part.

#### **Applicant's Argument**

"Looking specifically to amended claim 1, it relates to and recites a combination of elements including, for example, a "method in a computer system for enabling the development of implementation installation software by an expert for use by an end user to solicit and implement business related data for a software package comprising at least one independent module, the method comprising the steps of generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user; determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one

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independent module of the software package can be implemented and installed on the computer system of the end user; and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user," which is not disclosed or suggest by Profit. Rather, Profit discloses a software package that happens to have an installation wizard, but provides zero teaching regarding how that installation wizard was developed."

**Examiner's Response**

Applicant seems to be arguing that Microsoft commercial product Profit needs the source code to meet the burden to reject the application under the preponderance of evidence standard. One can see that the Wizard ask questions and the installation is generated based on the responses. Applicant's disclosure fails to distinguish from the product Microsoft generated software code for the commercial product.

**Applicant's Argument**

"The applicants readily admit that the Profit software package has an installation wizard and that the installation wizard both loads and implements the profit program, including interaction between databases, but the present invention as recited by the claims is not directed to a software package with an installation wizard but rather the present invention relates (to paraphrase) to the development of the installation wizard for the software package in the first instance. In fact, the difference between prior art and the present invention is clear by looking at the title of Profit 1. The title of Profit 1 is "Installing Microsoft Profit." In other words, the Profit 1 document steps you through installing profit using many windows and dialog boxes that are displayed to gather information from the end user. Profit 1 has no disclosure about development of the installation software, but rather simply uses software already develop, and it is silent regarding the development of the installation software. To the extent the Examiner believes the installation software associated with Profit was developed by generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user; determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the end user; and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user" is pure conjecture and using the teachings of the present invention to suppose that the programmers for profit must have developed the installation software in the

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same manner. In fact, the applicants are at a loss to find one reference in Profit I making any mention of how the installation software, including the screens and dialog, were developed. However, the mere fact that the installation programs work in a similar manner once developed is insufficient to support a finding of anticipation as Profit I does not enable the present invention. The only possible way the Examiner can reach the present conclusion is to use the teachings of the present invention and conclude the installation program for the Profit must have been developed using the present invention. However, this is improper use of hindsight.

For example, Profit 1 at page 26 shows a window displayed during the installation of Profit. The window display happens to have a question and solicits information from an end user. However, the fact that a window exists does not disclose how the screen, question, and dialog box in installation program was generated. The present invention relates to a method to generate the window displayed on page 26 and not the fact that the window exists. The fact that the window exists does not enable one of skill in the art to make or use the present invention because that window may have been created using a number of different programming techniques, some of which are disclosed in the background of the invention. As mentioned above, the Examiner is using impermissible hindsight to conclude that because the window in the installation software exists, it must have been developed using the present invention. However, that is simply not true.

The remaining references to Profit 1 identified by the Examiner show no more than additional window displays from the installation software for profit. The additional examples have no disclosure, suggestion, teaching, or information regarding how those windows were generated. As is clear, claim 1 relates to "the development of implementation installation software," and not to the use of that software once developed, to which Profit 1 is directed."

**Examiner's Response**

Examiner finds nothing new in this section. It appears to be cumulative from prior arguments.

**Applicant's Argument**

"Computer Security Basics and Sathi et al. do not relate to, disclose, suggest, or teach the development of installation software. Thus, they do not cure the defect noted above.

**Examiner's Response**

The reference was part of the rejection under U.S.C 103. Applicant has not clearly broken out the rejections. The reference was introduced to show the use of the limitations for well known security features.

**Applicant's Argument**

"For at least this reason, claim 1 is not anticipated by Profit 1. Amended independent claims 7, 11, 21, 29, and 32 contains limitations similar to amended claim 1 and at least by virtue of the similarity, are not anticipated by Profit 1. Claims 2-6 and 8-10, 11-13, 22-28, 30, and 31 depend either directly or indirectly from claims 1, 7, 11, 21, 29, and 32 and, at least by virtue of the dependency, are not anticipated by Profit 1. Moreover, because Computer Security Basics and Sathi et al. are silent regarding the development of installation software, thus, claims 1-13 and 21-32 are not anticipated or obvious in view of the references either alone or in any reasonable combination thereof. Thus, withdrawal of the rejection of pending claims and allowance of the claims is respectfully requested."

**Examiner's Response**

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Applicant's introduction of different roles is taken as admissions. First, the role of creating software which as discussed above can be an Expert. Applicant is arguing if the software for Profit ( a commercial for sale and for use product from Microsoft) was generated. The claimed invention fails to distinguish over the required generation of the commercial product.

**Applicant's Argument**

"In the November 29, 2005 Office Action the Examiner seems to misunderstand the present invention and based on the misunderstanding applies the references to reject the claims of the present invention. The Applicants believe the Examiner's apparent confusion would be clarified by a simple telephone conference or demonstration of the present invention, but the Examiner has denied requests for discussion. In any event, as explained in detail above, the Applicants completely, and clearly, traverse the rejections under 35 U.S.C. §§ 102(b) and 103(a). To the extent the Examiner is determined not to allow this clearly novel and unobvious patent application to proceed to issuance, the Applicants request the speedy issuance of a final rejection in this matter to move this long overdue case to appeal."

**Examiner's Response**

As stated previously, the Specification fails to distinguish over the reference Profit. Applicant may exercise their right to Appeal, Abandonment or Continuation. Applicant's arguments to date have been wholly unpersuasive.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

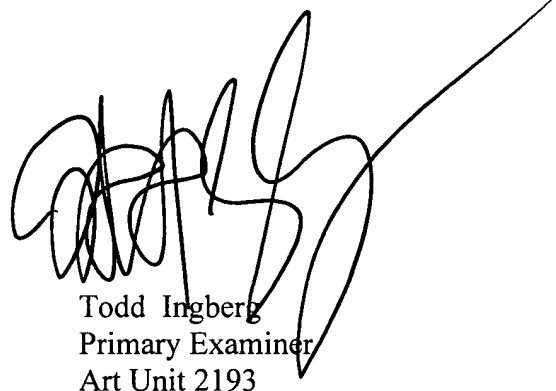
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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